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| 09/736,958      | 12/14/2000  | Darryl Costin JR.    | Camouflage/TL/SCH   | 8245             |

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EXAMINER

EDMONDSON, LYNNE RENEE

ART UNIT PAPER NUMBER

1725

DATE MAILED: 08/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

MS

**Office Action Summary**

Application No.

09/736,958

Applicant(s)

COSTIN, DARRYL

Examiner

Lynne Edmondson

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/4/02.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 27 recites the limitation "the user interface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-4, 6-9, 11-17, 19-24 and 26-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-8, 14, 20, 31, 41-57, 61, 62 and 64-71 of U.S. Patent No. 5990444. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims teach the same invention as the '444 claims but define the pattern scribes as a camouflage pattern. Both sets of claims teach use of an output file

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to control formation of the pattern on denim, energy densities per unit time and a plurality of images formed with different colors by varying intensity. Although the term "duty cycle" is not used in '444 claim 61, the step performs the same function as the duty cycle in instant claims 6 and 16. Although the '044 patent does not describe the pattern as camouflage (a pattern comprising different shades), claims 14, 20, 31 and 55 teach forming a graphic pattern at different levels of energy density to form different shades without completely penetrating the material. The instant claims teach the exact same method but use the term "camouflage" rather than regions of different shades. However, the method and results are identical. The '044 claims teach fading different parts of the material by applying different energy densities which forms different shades and different colors. See '044 claims 41-55, 48, 55 and 68-71.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the method to scribe a variety of types of graphics with differently shaded areas including but not limited to camouflage, rounded and lined patterns in a reliable and controlled manner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

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(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1, 2, 11-14, 19-21, 24, 26, 27, 29 and 30 are rejected under 35

U.S.C. 102(b) as being anticipated by Lockman et al. (USPN 5567207).

Lockman teaches a method of forming a graphic pattern which can be any shape or faded gradient on denim (col 3 lines 1-13 and lines 39-41) using an interface associated with a computer comprising an output file to control pattern formation on a textile (col 3 line 60 – col 4 line 4). The pattern may be defined by a single output file or combination thereof wherein an image is formed in a plurality of locations with different laser parameters to achieve particular characteristics (col 4 lines 29-52). Laser intensity may be varied to form different colors while operating within a range that will not damage the fabric (col 1 lines 21-30). Laser output may be expressed in a variety of ways including energy density per unit time (col 5 lines 1-21). The laser is controlled to scan in lines with varying power (col 3 lines 20-31 and col 4 lines 53-67). The shape may have rounded edges, polygonal portions or form strips (figure 3). See also Lockman claims 1-5, 1-26 and 29.

5. Claims 13-15, 20-24, 26, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Costin et al. (USPN 5916<sup>196</sup>~~464~~).

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Costin teaches a method of forming a graphic pattern which can be any shape such as curved and wavy faded lines (camouflage pattern) (col 3 lines 1-14, col 20 lines 8-31 and col 30 lines 30-42) using an interface associated with a computer comprising an output file to control pattern formation on a textile (col 2 lines 1-34 and col 6 lines 4-22). The pattern may be defined by a single output file or combination thereof wherein an image is formed in a plurality of locations with different laser parameters to achieve particular characteristics (col 2 lines 35-43 and lines 56-67). Laser intensity may be varied to form multiple colors while operating within a range that will not damage the fabric (col 17 line 46 – col 18 line 38 and col 26 line 48 – col 27 line 30). Laser output may be expressed in a variety of ways including energy density per unit time (col 28 lines 18-25 and claims 6-9). The material may be denim (col 30 lines 12-25). The laser is controlled to scan in lines with varying power (col 20 lines 5-31). The shape may have multiple rounded edges, polygonal portions or form cow-type spots (filled in circles) (col 3 lines 1-13, col 17 lines 4-27, col 18 lines 5-38 and figures 7, 21, 36 and 40). Plaid patterns and polka dots may also be formed (col 19 lines 47-67 and figures 17-18).

6. Claims 1-3, 5, 8-10, 13, 19-22, 24, 25, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Costin et al. (USPN 5916461).

Costin teaches a method of forming a graphic pattern which can be any shape such as wavy faded lines (camouflage pattern) (col 1 lines 28-45 and claim 5) using an interface associated with a computer comprising an output file to control pattern

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formation on a textile. The pattern may be defined by a single output file (col 8 lines 51-56) or combination thereof wherein an image is formed in a plurality of locations with different laser parameters to achieve particular characteristics (col 5 lines 21-43) including color (col 6 lines 33-41). Laser intensity may be varied to form multiple patterns in multiple areas (col 7 lines 16-40 and col 11 lines 19-67) while operating within a range that will not damage the fabric (col 7 lines 49-67 and col 9 lines 21-52). The material may be denim (col 2 lines 17-25). The laser is controlled to scan in lines with varying power (2 line 60 – col 3 line 16 and col 11 lines 1-18). Random patterns are formed with the aid of a random number generator (col 7 lines 37-41 and col 8 lines 1-12). The shape may have rounded edges, polygonal portions or form cow-type spots (filled in circles) (col 7 lines 30-35 and figure 10c). See Costin claims 5-10.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Costin et al. (USPN 6252196 B1).

Costin teaches a method of forming a graphic pattern which can be any shape such as curved and wavy faded lines (camouflage pattern) (col 3 lines 1-14, col 20

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lines 8-31 and col 30 lines 30-42) using an interface associated with a computer comprising an output file to control pattern formation on a textile (col 2 lines 1-34 and col 6 lines 4-22). The pattern may be defined by a single output file or combination thereof wherein an image is formed in a plurality of locations with different laser parameters to achieve particular characteristics (col 2 lines 35-43 and lines 56-67). Laser intensity may be varied to form multiple colors while operating within a range that will not damage the fabric (col 17 line 46 – col 18 line 38 and col 26 line 48 – col 27 line 30). Laser output may be expressed in a variety of ways including energy density per unit time (col 28 lines 18-25 and claims 6-9). The material may be denim (col 30 lines 12-25). The laser is controlled to scan in lines with varying power (col 20 lines 5-31). The shape may have multiple rounded edges, polygonal portions or form cow-type spots (filled in circles) (col 3 lines 1-13, col 17 lines 4-27, col 18 lines 5-38 and figures 7, 21, 36 and 40). Plaid patterns and polka dots may also be formed (col 19 lines 47-67 and figures 17-18). However, there is no disclosure of the number of colors present or of color assignment.

It would have been obvious to one of ordinary skill in the art at the time of the invention to optimize the process by using at least three assigned colors (dark , light and gradual changes in between, Costin, col 17 lines 46-67) yet no more than 20 colors to create intricate graphics (Costin, col 26 lines 47-67 and col 30 lines 30-42) without losing detail (Costin, col 27 lines 24-31) in a simple and cost-effective manner (Costin, col 30 lines 48-53).



***Response to Arguments***

8. Regarding applicant's argument that the instant claims do not merely cover forming patterns on textile materials but rather cover forming specific types of patterns on textiles in a new way, applicant admits that both sets of claims define using an output file to form a pattern on denim. Although the '044 patent does not describe the pattern as camouflage (a pattern comprising different shades), claims 14, 20, 31 and 55 teach forming a graphic pattern at different levels of energy density to form different shades without completely penetrating the material. The instant claims teach the exact same method but use the term "camouflage" rather than regions of different shades. However, the method and results are identical. The '044 claims teach fading different parts of the material by applying different energy densities which forms different shades.

Therefore the rejection of claims 1-4, 6-9, 11-17, 26, 27, 29 and 30 as rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-3, 5-8, 46-57, 61, 62 and 64-71 of U.S. Patent No. 5990444 stands and now includes claims 19-24, 28 and 31.

9. Regarding applicant's argument that the Lockman reference does not teach a camouflage pattern, although the reference does not teach the term "camouflage" (a pattern comprising different shades), the reference does teach forming a graphic pattern at different levels of energy density to form different shades and different colors without damaging the material (col 4 lines 29-52). Laser intensity may be varied to form different colors while operating within a range that will not damage the fabric (col 1 lines

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21-30). The laser is controlled to scan in lines with varying power (col 3 lines 20-31 and col 4 lines 53-67). The shape may have rounded edges, polygonal portions or form strips (figure 3). The instant claims teach the exact same method but use the term "camouflage" rather than regions of different shades. However, the method and results are identical.

Therefore the 102 rejection of claims 1, 2, 11-14, 19-21, 24, 26, 27, 29 and 30 as anticipated by Lockman stands.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., camouflage pattern) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore the 102 rejection of claims 13-15, 20-24, 26, 29 and 30 as anticipated by Costin et al. (USPN 6252196 B1) and the 103 rejection of claim 18 as obvious over Costin et al. (USPN 6252196 B1) stand.

11. Regarding applicant's argument that the instant claims do not merely cover forming patterns on textile materials but rather cover forming specific types of patterns on textiles in a new way, applicant admits that both sets of claims define using an output file to form a pattern on denim. Although the '461 Costin reference does not use the

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term "camouflage" (a pattern comprising different shades), '461 teaches forming a graphic pattern at different levels of energy density to form random patterns wherein different intensity is introduced at different spots on the denim ('461 claims 1 and 3 and col 3 lines 1-16) without completely penetrating the material which will produce differently shaded areas. Laser spot size and output are controlled to achieve the desired look regardless of the name used for the look (col 5 lines 8-58). The instant claims teach the exact same method but use the term "camouflage" rather than regions of different shades as a result of different laser energies applied as a result of probability (col 6 line 42 – col 7 line 35). The '461 claims teach fading different parts of the material by applying different energy densities which forms different shades. Differently shaded wavy lines form a camouflage pattern whether that term is used or not. The design may take any shape (col 7 lines 30-35) including wavy lines (col 1 lines 28-45 and claim 5). Each matrix produces a unique output pattern (col 7 lines 1-9). In both cases, the methods and results are identical.

Therefore the 102 rejection of claims 1-3, 5, 8-10, 13, 19-22, 24, 25, 29 and 30 as anticipated by Costin et al. (USPN 5916461) stands.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Greisz (USPN 5999252, laser marker, random number generator), Carpentier et al. (USPN 6287184 B1), Costin et al. (USPN 6252196 B1),

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Costin et al. (USPN 6315202 B2), Martin et al. (USPN 6002099), Sanduja et al. (USPN 5741548), McLaughlin (USPN 6090158), Huber et al. (USPN 630144 B1) and Moore (USPN 6246778 B1).

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne R. Edmondson whose telephone number is 703-306-5699. The examiner can normally be reached on M-F from 7-4, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on 703-308-3318. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Lynne Edmondson  
Examiner  
Art Unit 1725

LRE  
August 7, 2002



M. ALEXANDRA ELVE  
PRIMARY EXAMINER